

DETAILED ACTION

Response to Amendment

1. This Office action is in response to Applicant's amendments filed 28 February 2011, which amends claim 1.

Claims 1 and 2 are pending.

2. Applicants overcame the rejection of claims 1 and 2 under 35 U.S.C. 103(a) as being unpatentable over Kwong et al. (US 2002/0074935 A1) in view of Ise et al. (US 2002/0028329 A1) as evidenced by Tsukahara et al. (US 2006/0057427 A1) and Satou (US 2008/0054799 A1) by amending the claims and presenting persuasive evidence of unexpected results in the reply filed 28 February 2011.

Specification

3. The attempt to incorporate subject matter into this application by reference to JP-2002-319491-A is ineffective because the specification does not state the words "incorporate" or "reference".

4. The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective.

Compliance will not be held in abeyance with respect to responding to the objection,

rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f).

5. The amendment filed 28 February 2011 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: formula (B-X) and the description of the variables in the formula (B-X).

Claim Rejections - 35 USC § 112

6. Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

While the specification supports instant formula (H-II) it does not appear to contain support for instant formula (B-X). The specification cites JP-2002-319491-A as containing formula (B-X); however the incorporation of this reference is ineffective. Therefore the formula is considered to be new matter.

Response to Arguments

7. Applicant's declaration filed 28 February 2011 has been fully considered and is persuasive. The declaration presents evidence of unexpected results commensurate with the scope of the present claims (with instant formula (B-X)) and is therefore effective in overcoming the rejection of record utilizing Kwong et al. (US 2002/0074935 A1).
8. Applicant's arguments filed 28 February 2011 have been fully considered but are not persuasive.

Applicants argue that instant formula (B-X) was incorporated by reference and is not new matter. However the incorporation by reference is ineffective because it fail to comply with 37 CFR 1.57(b)(1). The intent to incorporate appears to be unclear because it is merely a listing of many materials which may be suitable, please see 37 CFR 1.57(g)(1).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. WILSON whose telephone number is (571) 270-3882. The examiner can normally be reached on Monday - Thursday 7:30-5:00 (EST), Friday 7:30-4:00 with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Chriss can be reached on (571) 272-7783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MHW

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1787